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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/587,058 | 06/02/2000 | Bernhard Schierling | 4452-195RE | 6846 |

7590 01/29/2003

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EXAMINER

BONCK, RODNEY H

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| ART UNIT | PAPER NUMBER |
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3681

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/587,058

Applicant(s)

SCHIERLING, BERNHARD

Examiner

Rodney H. Bonck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The following action is in response to the amendment received September 30, 2002, Paper No. 19.

Reissue Applications

Claims 5-8 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

During the prosecution of the patent upon which this reissue is based, claims were presented that required that the insulating member comprise a metal portion and an additional portion and that the metal portion of the insulating member have a resistance to thermal conductivity that is greater than that of either the pressure plate or

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the membrane spring. These claims were considered to distinguish over the prior art and became claims 1-4 of the patent. Claims 5-8 do not include this limitation and thus are broader with respect to this aspect germane to the prior art rejection applied in the parent, even though the claims might be narrower in other aspects. Therefore, these claims are seen as attempting to recapture the broader scope surrendered in the application for the patent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 8 is rejected under 35 U.S.C. 102(a and e) as being anticipated by Hays('704). Hays discloses a single disc friction clutch comprising a clutch housing 12,

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a single clutch disc 14, a pressure plate 16, a friction lining 18 on the clutch disc, a membrane spring 30, and a thermal insulating member 59 (Fig. 4). A first portion of the pressure plate is disposed to contact the clutch disc. The ball 44 can be considered a second portion of the pressure plate disposed between the insulating member 59 and the membrane spring 30. The thermal insulating member is configured to minimize the contact between the thermal insulating member and the membrane spring (see column 3, lines 50-67) and thus is configured to minimize heat conduction from the pressure plate to the membrane spring. The thermal insulating member is rigid and comprises a metal and is a single, one-piece element extending circumferentially above the pressure plate.

Allowable Subject Matter

Claims 1-4 are allowed.

Response to Arguments

Applicant's response overcomes the objection to the specification set forth in the Office action of February 20, 2002, Paper No. 14.

Applicant argues that claim 8 is narrower than the patent claims since it recites such structure as the pressure plate protrusion not previously claimed. As noted above, however, the claims that were allowed in the parent application were amended to recite the combination of the insulating member comprising a metal portion and an additional portion wherein the metal portion of the insulating member has a resistance to thermal

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conductivity that is greater than that of either the pressure plate or the membrane spring. Since all of claims 5-8 lack this limitation, they are broader in an aspect germane to the rejection and thus are seen as an attempt to recapture subject matter surrendered in the application for the patent.

Hays('704) is still seen to anticipate claim 8 since retainer ring 59 is disclosed as being metal and configured to minimize heat conduction, the balls 44 being readable as a second portion of the pressure plate. The rejection of claims 5-7 under 35 USC 103 is withdrawn since the, as applicant correctly points out, the ring 42 in Maycock et al.(EP 0 235 882) is resilient, not rigid, as claimed.

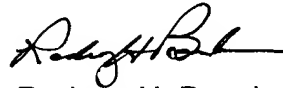
Since the rejection based on Hays('704) interprets the reference slightly differently than in the rejection set forth in Paper No. 14, this action is a non-final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney H. Bonck whose telephone number is (703)-308-2904. The examiner can normally be reached on Monday-Friday 7:30AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on (703)-308-0830. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-305-3597 for regular communications and (703)-305-3597 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1113.



Rodney H. Bonck
Primary Examiner
Art Unit 3681

rhb
January 22, 2003